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| 10/563,257 | 07/05/2006 | Christian Neumann | NEUMANN=3 | 1268 |
| 1444 7590 04/01/2010 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303 | | | | |
| EXAMINER | | | | |
| COOLEY, CHARLES E | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1797 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,257

Applicant(s)

NEUMANN, CHRISTIAN

Examiner

Charles E. Cooley

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 3, 6-12, 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

FINAL OFFICE ACTION

1. **This application remains assigned to Technology Center 1700, Art Unit 1797 and the following will apply for this application:**

Please direct all written correspondence with the correct application serial number for this application to **Art Unit 1797**.

Telephone inquiries regarding this application should be directed to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 or to the Examiner at (571) 272-1139. All official facsimiles should be transmitted to the centralized fax receiving number 571-273-8300.

Priority

2. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All of the CERTIFIED copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

Drawings

3. The replacement sheet of drawings filed 23 FEB 2010 is approved.

Specification

4. The substitute Abstract of the Disclosure is approved.
5. The title is acceptable.

Claim Rejections - 35 USC § 103

6. The terms used in this respect are given their broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art, in light of the written description in the specification, including the drawings, without reading into the claim any disclosed limitation or particular embodiment. See, e.g., *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). The Examiner interprets claims as broadly as reasonable in view of the specification, but does not read limitations from the specification into a claim. *Elekta Instr. S.A.v.O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 1307 (Fed. Cir. 2000).
7. To determine whether subject matter would have been obvious, "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

The Supreme Court has noted:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740-41 (2007). "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." (Id. at 1742).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

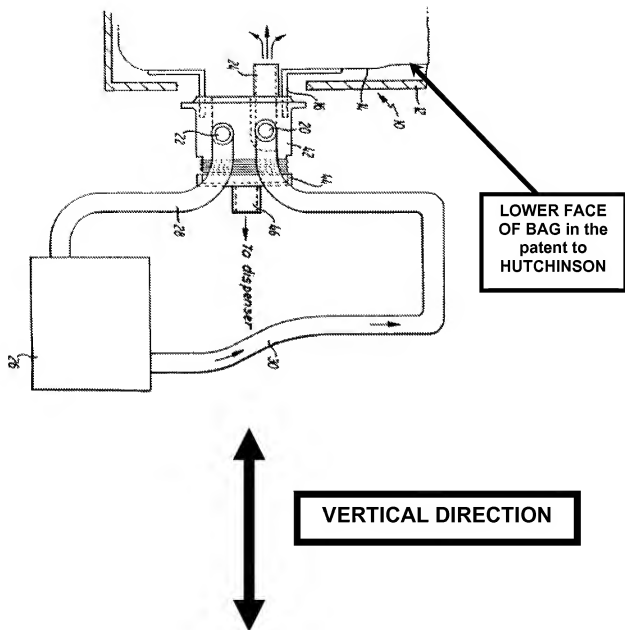
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 5,941,635) in view of Hutchinson (US 5,121,857).

The patent to Stewart '635 discloses a system and method including a rigid container 14; peristaltic pump 73; a bag 12 installed in the rigid container 14 (Fig. 1); the bag 12 being disposable (col. 2, lines 18-19) and thus intended to be a single-use bag; the upper face 18 of the bag includes an orifice 38 for the liquid to return through which said liquid returns to the inside of the bag, said orifice is connected in fixed manner by means of an external mixing duct 68 which is inserted into the pump 73; the pump 73 being open (a peristaltic type pump) so that the mixing duct 68 can be removably inserted into and extracted from the pump whereby the pump is actuated to produce a closed-circuit circulation of the liquids to carry out the mixing (Fig. 2 and col. 5, lines 1-18). Stewart does not disclose the lower face of the bag includes an orifice for the liquid

to discharge to the outside of the bag or the bottom of the container is fitted with an elongated slit allowing the insertion and the passage of the mixing duct such that the lower and upper faces of the bag are connected.

The patent to Hutchinson discloses a system and method including a rigid container 12; peristaltic pump 26 connected to external mixing duct 18, 28; a bag 14; the lower face of the bag 14 includes an orifice 16 for the liquid to discharge to the outside of the bag (as illustrated below); the bottom of the container 12 is fitted with an elongated slit (about 16 - Fig. 1) allowing the insertion and the passage of the mixing duct 18, 28. It would have been obvious and mere common sense to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the lower face of the bag in Stewart with an orifice for the liquid to discharge to the outside of the bag and the bottom of the container with an elongated slit allowing the insertion and the passage of the mixing duct for the purposes of dispersing the solid particles that have settled in the bottom of the bag back into the liquid in the bag (col. 1, lines 11-15 and col. 2, lines 23-34).



10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 5,941,635) in view of Hutchinson (US 5,121,857) as applied to claim 1 above and further in view of Bibbo et al. (US 2003/0231546 A1).

Stewart (US 5,941,635) in view of Hutchinson (US 5,121,857) do not disclose the door. Bibbo et al. discloses an analogous system including a rigid container 20 for holding a mixing bag 202 wherein the container 20 has a door 25 thereon. It would have been obvious and mere common sense to one having ordinary skill in the art, at the time applicant's invention was made, to have provided the container of Stewart in view of Hutchinson with a door as taught by Bibbo et al. for the purpose of allowing selective access to the interior of the container and enabling closing off the container (see ¶ [0086] – [0091]).

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart (US 5,941,635) in view of Hutchinson (US 5,121,857) as applied to claim 13 above and further in view of Bibbo et al. (US 2003/0231546 A1).

Stewart (US 5,941,635) in view of Hutchinson (US 5,121,857) do not disclose the flow rate. The patent to Thanoo et al. discloses a recirculation circuit (Fig. 4) with a mixing vessel 316, external mixing line 322, and a Watson-Marlow peristaltic pump 340. The pump is operated to provide a flow rate of a recirculated mixture within the recited range. It would have been obvious and mere common sense to one having ordinary skill in the art, at the time applicant's invention was made, to have operated the peristaltic pump in Stewart in view of Hutchinson to provide a flow rate within the recited

range since Thanoo et al. teaches such a flow rate is suitable for a recirculation system (col. 10, lines 54-66).

Allowable Subject Matter

12. Claims 3, 6-12, and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claim 5 is allowable over the prior art of record.

Response to Amendment

14. Applicant's arguments filed 23 FEB 2010 have been fully considered but they are not persuasive.

With regard to the remarks on the patent to Stewart on p. 13 of the response, the examiner respectfully disagrees with the sated characterization of this patent. Applicant states "There is a further difference between claim 1 and STEWART; the reference also does not disclose that the upper face of the media bad includes an orifice for the liquid to return through which said liquid returns to the inside of the bag. STEWART discloses that only the mixing block 60 at the bottom of the media bag allows fluid to return inside the media bag (column 5, lines 14-16)." However, Stewart clearly teaches that the orifice 36 at the upper face of the bag allows returned liquid to enter the inside region of the bag (col. 3, lines 52-55 and col. 5, lines 1-4). Claim 1 does not recite at what particular location inside the bag the liquid is returned, so the return entry of liquid into

the bag through upper face port 36 and mixing block 60 meets the broad scope of claim 1. In stark contrast, note that new claim 16 specifically recites at what location in the bag the liquid is returned (i.e., the "upper-most part of the bag") and this claim is therefore allowable as distinguishing over the lower region mixing block liquid entry of Stewart, commensurate with Applicant's remarks.

With regard to the combination of STEWART and HUTCHINSON, the examiner in fact asserted in the last office action that the lower face of the bag 14 in Hutchinson included an orifice 16 for discharge of the liquid (Fig. 1 of Hutchinson). The examiner has further emphasized this aspect by the annotated Figure 1 of Hutchinson above explicitly showing an orientation wherein the orifice 16 is located in the lower face of the bag. However, Applicant argues that the orifice 16 is on a lateral (side) surface of the bag (p. 15 of the response).

While it is agreed that Hutchinson shows in Fig. 1 the apparatus shifted 90 degrees from the manner in which the examiner has interpreted this reference, turning a prior art apparatus by such a shift does not result in a different device. The orientation of a claimed apparatus with respect to an object which is not part of the claimed structure, such as the surface of the Earth, is not germane to the patentability of the apparatus itself, but instant relates to the in manner in which the apparatus is used. Applicant has not identified any structural difference between the claimed lower face of the bag with an orifice and Hutchinson's lower bag face with an orifice. The only distinction to which Applicant can aver is a difference in the location or orientation of the bag during use, and it is well settled that an intended use does not render the claimed apparatus

structure novel or unobvious over the structure of Hutchinson. Such an intended use has not been afforded any patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647; *In re Sebald*, 122 USPQ 527; *In re Lemin et al.*, 140 USPQ 273; *In re Sinex*, 135 USPQ 302; *In re Pearson*, 181 USPQ 641. Moreover, any argument inferring that such a shift would render the device of Hutchinson inoperable or inefficient will be summarily dismissed, as shifting the apparatus as presented in the action would likely improve (not hinder) mixing and discharge of the liquid from the bag since gravitational forces would aid in the discharge of liquid through the bottom mounted discharge port.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION

FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION. ANY RESPONSE FILED AFTER THE MAILING DATE OF THIS FINAL REJECTION WILL BE SUBJECT TO THE PROVISIONS OF MPEP 714.12 AND 714.13.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley in Art Unit 1797 whose telephone number is (571) 272-1139. The examiner can normally be reached on Mon-Fri.. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles E. Cooley/

Charles E. Cooley
Primary Examiner
Art Unit 1797

2 April 2010